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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/031,225	06/05/2002	Brian P. McDonald	ACD2713	6198

7590

12/29/2003

Ralph J Mancini  
Akzo Nobel Inc  
Intellectual Property Department  
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EXAMINER
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QAZI, SABIHA NAIM

ART UNIT	PAPER NUMBER
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1616

DATE MAILED: 12/29/2003

9

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/031,225

Applicant(s)

MCDONALD ET AL.

Examiner

Sabiha Qazi

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on 22 September 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☐ Claim(s) 10-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.

6) ☐ Claim(s) 10-25

is/are rejected.

7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.

8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

***Non-Final Action on Merits***

Acknowledgement is made of amendments filed on 9/22/03. Amendments are entered. Claims 10-25 are pending. No claim is allowed at the present time. This application is a 371 of PCT/EP00/06234 filed on 07/03/2000. Instant invention is drawn to a composition useful for the breaking of rest in deciduous fruit species comprising an organic nitrogen-containing compound selected from the group consisting of ethylenediamine, ethylenediamines, etc.

Arguments on art rejection were fully considered but are not found persuasive because adding surfactants to a composition taught by the prior art has showed no criticality of invention. Surfactants are used the composition in absence of unexpected and/or unobvious results rejection under 103 is maintained for the same reasons as set forth in our previous office action.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 10-17 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 10 and 11 of U.S. Patent No. 5,693,591.

Although the conflicting claims are not identical, they are not patentably distinct from each other because a composition useful for the breaking of rest in deciduous fruit species comprising an organic nitrogen-containing compound selected from the group consisting of ethylenediamine, ethylenediamines, etc. See the following reasons as discussed in 103 rejection.

Claims 10-25 stand rejected under 35 U.S.C. 103(a) as being unpatentable over US 5693591 and US 5885932. See both documents in their entirety, especially the abstracts, examples, and all claims.

Presently claimed invention is drawn to a composition useful for the breaking of rest in deciduous fruit species comprising an organic nitrogen-containing compound selected from the group consisting of ethylenediamine, ethylenediamines, etc.

US '591 discloses activity promoting additives for rest-breaking agents. The activity promoting additives enhance the activity of rest-breaking agents thereby leading to improvements in the yields and quality of fruit from deciduous fruit trees.

US '932 and US '591 are very much alike; the only difference is that US '932 teaches activity leading to improvements in the yields and quality of fruit from *non*-deciduous fruit trees.

Instant claims differ from prior art in that neither reference discloses the groups stated in Claim 10. However, US '591 discloses, "Typical compounds suitable for use in the process of the present invention include, but are not limited to..." This means that the composition *comprises* the groups listed in the patent and could include the groups listed in the presently claimed invention. (See lines 53-54 in Column 4).

It would have been obvious to one skilled in the art at the time of invention to create a composition useful for breaking the rest in deciduous fruit species containing an organic nitrogen-containing compound because US '591 teaches rest-breaking compositions that improve in the yields and quality of fruit from deciduous fruit trees. Since Applicant's Claim 10 is very similar to US '591's Claim 10, one who is familiar with the art would be motivated to prepare a rest-breaking composition to improve the yields and quality of fruit from deciduous fruit trees. The motivation to combine the teachings of the prior art *Supra* would have been obvious at the time of invention. Addition of a surfactant in the composition is conventional and

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is considered to be obvious to one skilled and familiar with the art. All the components are taught by the prior art.

In absence of any criticality and/or unexpected results presently claimed invention is considered obvious over the prior art of record.

In the light of the forgoing discussion, the Examiner's ultimate legal conclusion is that the subject matter defined by the instant claims would have been obvious within the meaning of 35 U.S.C. 103(a).

***Telephonic Inquiry***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sabina Qazi whose telephone number is 703-305-3910. The examiner can normally be reached on every business day..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman Page can be reached on 703-308-2927. The fax phone number for the organization where this application or proceeding is assigned is 703-308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.



SABIHA QAZI, PH.D  
PRIMARY EXAMINER